

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 53

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FREDERICK M. STEFANSKY

Appeal No. 1998-0690
Application No. 08/562,796

ON BRIEF

Before JERRY SMITH, FLEMING, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-5, 19, 23-25 and 28-33, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a disk drive having support posts aligned with storage disk and actuator mounting points to reduce mechanical off-tracking. An understanding of the invention can be derived from a reading of exemplary claim 23, which is reproduced below.

23. A disk drive responsive to a host computer, comprising:

a head-disk assembly, including:

a base having a top, a bottom, a length corresponding to sides of said base, and a width corresponding to ends of said base, said width being less than said length;

four support posts provided on said base spaced inward from said ends for securing the disk drive within the host computer, said four support posts capable of providing an area on said base defined by said four support posts with an increased rigidity upon the disk drive being secured to the host computer,

storage means for storing data, said storage means mounted at a point on said base within said area of increased rigidity,

interactive means for reading information from and writing information on said storage means,

actuator means, supported on said base and responsive to control signals, for positioning said interactive means with respect to said storage means, said actuator means being mounted at a point on said base within said area of increased rigidity, and

a cover sealably attached to said base to enclose said storage means, said interactive means, and said actuator means; and

control means, mounted on said bottom of said base, for generating control signals to control said actuator means and for providing information signals to and receiving information signals from said interactive means.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Morehouse et al. (Morehouse)	4,933,785	Jun. 12, 1990 (Filed Mar. 01, 1988)
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Claims 1-5, 19, 23-25 and 28-33 stand rejected under obvious-type double patenting over claims 1, 7-9, 14 and 16 of US Patent 5,025,335. Claims 1-5, 19, 23-25 and 28-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Morehouse. The examiner has further set forth an objection to claims which we will not address since such formal matters are beyond our authority.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 48, mailed Oct. 2, 1997) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 47, filed Jun. 20, 1997) for the appellant's arguments thereagainst.

OPINION

¹ We note that claim 4 does not appear to be properly amended in the last sentence ending in " , said base, ." (See amendment filed Sep. 9, 1996.)

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

OBVIOUS-TYPE DOUBLE PATENTING

At the outset we acknowledge that the examiner does not mention the fact that the originally issued claims from the US Patent 5,025,335 have been modified through a reexamination proceeding. Since the claims have been changed, the proper claims for evaluation of any double patent rejection must be to the reexamined claims as recited in the Reexamination Certificate B1 5,025,335. (See brief at page 19 et seq.) From our review of the examiner's brief discussion, we find that the examiner has not set forth a comparison of the present claims to the reexamined claims beyond the statement that the patented claims do not recite a limitation concerning 4 support posts. (See answer at pages 4-5.) In our opinion the examiner has not set forth a comparison of the reexamined claims to the present claims on appeal to establish a ***prima facie*** case of obvious-type double patenting. Therefore, we will not sustain the rejection of claims 1-5, 19, 23-25 and 28-33 under obvious-type double patenting.

35 U.S.C. § 103

We note that appellant has set forth four groupings of claims, yet we note that a number of claims do not contain the argued limitations. Each of the independent claims have slight variations in the combination of claim limitations with respect to the number and placement of posts and respective orientation of the actuator and disk. Regardless of the grouping, we find that the examiner has not set forth a ***prima facie*** case of obviousness.

Appellant argues that the circuit board of Morehouse is not “immediately adjacent” to the base. (See brief at pages 6-7.) We agree with appellant. In view of the ordinary definition of adjacent as modified by immediately, it is clear that the spaced relation cited at column 17 of Morehouse would not teach or fairly suggest the claimed relationship as recited in claim 2 and dependent claim 3. Therefore, we will not sustain the rejection thereto.

Appellant argues that Morehouse does not teach or fairly suggest the area of increased rigidity, placement of posts relative to the ends of the drive or the placement of the actuator and/or disk substantially on a line between the posts or within the area of increased rigidity. While we agree with the examiner that the affixation of the mounts 212 shown in Figures 12A and 12B of Morehouse would inherently provide some increased rigidity when affixed to the computer, it is not clear from the express disclosure of Morehouse that increased rigidity is needed or desired. Furthermore, the

examiner states that one pair of posts are parallel to the sides of the drive, but the claims require that the posts be parallel to the end. (See answer at page 6.) We disagree with the examiner that the skilled artisan would have been motivated to provide a fourth post. If four posts were present, then they would be placed in the corners and therefore not inward from the end with the actuator or disk mounted on a line between a pair of posts. From our review of Morehouse, it appears that the actuator and the disk MAY be mounted within the triangular area formed by the mounting posts, but Morehouse does not disclose expressly this orientation or show it in the drawings. Therefore, this would be speculation on our part absent a convincing line of reasoning. We find that the examiner has not provided any convincing line of reasoning for orienting the physical placement of the claimed elements. Therefore, we cannot accept the examiner's conclusions and modifications to the basic teachings and suggestions of Morehouse. (See answer at pages 5-8.)

Since the examiner has not provided a teaching or suggestion of all of the claimed limitations, we cannot sustain the rejection of claims 1-5, 19, 23-25 and 28-33.

CONCLUSION

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To summarize, the decision of the examiner to reject claims 1-5, 19 and 23-25 and 28-33 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH
Administrative Patent Judge

MICHAEL R. FLEMING
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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